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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,356	08/01/2003	John P. Romeo	130332.00072	3704
67942	7590	11/28/2007		
RAMAN N. DEWAN JACKSON WALKER, L.L.P. 100 CONGRESS AVENUE SUITE 1100 AUSTIN, TX 78701			EXAMINER PHAN, JOSEPH T	
			ART UNIT 2614	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/633,356	Applicant(s) ROMEO ET AL.	
	Examiner Joseph T. Phan	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10, 12-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-10, 12-19, 21-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/29/07 has been entered.

Claim Objections

2. Claim 9 objected to because of the following informalities: Line 1 recites "the method of claim 21 The method of claim 2" Claim 2 is cancelled. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claims 3-10, 12-19, 21 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Uppaluru, Patent #5,915,001 in view of Enzmann, Patent #6,320,946.**

Regarding claim 3, Uppaluru in view of Enzmann teaches the method of Claim 21, wherein the telephone call is a wire line call from the user(Uppaluru lines 6-22).

Regarding claim 4, Uppaluru in view of Enzmann teaches the method of Claim 21, wherein the telephone call is a wireless call from the user(Uppaluru lines 6-22).

Regarding claim 5, Uppaluru in view of Enzmann teaches the method of Claim 21. Uppaluru does not specifically teaches wherein the text format is XML format.

In the same field of endeavor, Enzmann teaches wherein the text format is XML format (col. 9, lines 12-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the format of Uppaluru to include XML as taught by

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Enzmann so that the web site creator can create customized tags that are specific for them and their customers and so that any web page document that a calling party request can be retrieved for them.

Regarding claim 6, Uppaluru in view of Enzmann teaches the the IVR input is telephone keypad input(Uppaluru col.19 lines 6-7).

Regarding claim 7, Uppaluru in view of Enzmann teaches the method of Claim 21, wherein the IVR input is voice input(Uppaluru col.19 lines 6-7).

Regarding claim 8, Uppaluru in view of Enzmann teaches the method of Claim 21, wherein for Internet access, the step of receiving IVR input is followed by the steps of providing an IVR menu of Internet content selections and of receiving IVR input representing an Internet content selection(Uppaluru col.19 lines 1-23).

Regarding claim 9, Uppaluru in view of Enzmann teaches the method of Claim 21, wherein the Internet content includes email messages(Uppaluru col.9 lines 48-56).

Regarding claim 10, Uppaluru in view of Enzmann teaches the method of Claim 21, further comprising the steps of presenting the user with an option to change preferences and of receiving IVR input representing one or more preference settings(Uppaluru fig.5 and col.2 linse 42-52).

Regarding claim 12, Uppaluru in view of Enzmann teaches the system of Claim 22, wherein the IVR system is operable to receive the calling card call from a wire line telephone(Uppaluru lines 6-22).

Regarding claim 13, Uppaluru in view of Enzmann teaches the system of Claim 22, wherein the IVR system is operable to receive the calling card call from a wireless

telephone(Uppaluru lines 6-22).

Regarding claim 14 in view of Claim 5, Uppaluru in view of Enzmann teaches the system of Claim 22, wherein the translator translates text in XML format to audio data(Uppaluru col.8 lines 16-24).

Regarding claim 15, Uppaluru in view of Enzmann teaches the system of Claim 22, wherein the IVR system is further operable to provide menu selections representing Internet content selections(Uppaluru col.2 lines 7-10, col.3 lines 41-48, and col.19 lines 1-23).

Regarding claim 16, Uppaluru in view of Enzmann teaches the system of Claim 22, wherein the IVR system is further operable to receive IVR input representing Internet content selections(Uppaluru col.2 lines 7-10, col.3 lines 41-48, and col.19 lines 1-23).

Regarding claim 17, Uppaluru in view of Enzmann teaches the system of Claim 22, wherein the IVR system is further operable to receive IVR input representing portal preferences and to communicate data representing the preferences to the portal server(Uppaluru abstract, col.8 lines 16-24 and col.19 lines 1-23).

Regarding claim 18, Uppaluru in view of Enzmann teaches the system of Claim 22, wherein the IVR system is operable to receive IVR input wherein the IVR input is telephone key input(Uppaluru col.19 lines 6-7).

Regarding claim 19, Uppaluru in view of Enzmann teaches the system of Claim 22, wherein the IVR system is operable to receive IVR input wherein the IVR input is voice input(Uppaluru col.19 lines 6-7).

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Regarding claim 21, Uppaluru teaches a method of providing a telephone user with access to Internet content, comprising the steps of:

responsive to an interactive voice response (IVR) system receiving a calling card call from a conventional telephone via the public switched telephone network (PSTN)(col.9 lines 57-64), responsive to determining the user selected Internet access(col.2 lines 7-10, col.3 lines 41-48, and col.19 lines 1-23), performing the following steps: receiving IVR input from the user representing a password(col.3 lines 1-17 and col.19 lines 1-23); providing the user with a preference selection menu(col.19 lines 1-23); providing the user with a content selection menu(col.19 lines 1-23); receiving IVR input from the user representing Internet content selection(col.2 lines 7-10, col.3 lines 41-48, and col.19 lines 1-23); communicating the content selection to an Internet server via modemless communications(Fig.1, col.2 lines 22-41); translating the Internet content from text format to audio data(col.8 lines 16-24 and col.17 line 59-col.18 line 28); and transmitting the audio data to the conventional telephone via the PSTN(col.8 lines 16-24 and col.17 line 59-col.18 line 28).

Uppaluru does not specifically teach prompting the user to select between a voice call and internet access and responsive to determining the user selected the voice call, completing the telephone call to a destination telephone number

In the same field of endeavor, Enzmann teaches prompting the user to select between a voice call and internet access and responsive to determining the user

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selected the voice call, completing the telephone call to a destination telephone number(Enzmann abstract, col.2 lines 6-17, col.7 lines 3-15, and col.10 lines 23-39).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Uppaluru by providing access to telephony calls with the calling card so that the user can access both internet and regular voice calls via the same access card. This will also simplify billing since the user is charged for both services under one account.

Regarding claim 21, Uppaluru teaches a system for enabling Internet access to a user of a conventional telephone and the public switched telephone network (PSTN)(abstract and Fig.1), comprising an interactive voice response (IVR) system operable to: when the user selects Internet access(col.2 lines 7-10, col.3 lines 41-48, and col.19 lines 1-23):

instruct a server to retrieve Internet content and deliver the Internet content to a translator(col.8 lines 16-24);

instruct the translator to translate the Internet content to audio data and deliver the audio data to the conventional telephone(col.8 lines 16-24).

Uppaluru does not specifically teach prompting the user to select between a voice call and Internet access upon receiving an incoming calling card call from the conventional telephone and complete a telephone call connection when the user selects a voice call.

In the same field of endeavor, Enzmann teaches prompting the user to select between a voice call and Internet access upon receiving an incoming calling card call

from the conventional telephone and complete a telephone call connection when the user selects a voice call (Enzmann abstract, col.2 lines 6-17, col.7 lines 3-15, and col.10 lines 23-39).

Response to Arguments

7. Applicant's arguments with respect to claims 3-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T. Phan whose telephone number is (571) 272-7544. The examiner can normally be reached on Mon-Fri 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

08/15/2007 JTP

